

REMARKS

The text of the specification on page 18 from lines 3-14 has been amended to correct graphic formula XV of Reaction D by the addition of a hydrogen atom (shown as underlined). Basis for this amendment is found in lines 7-10 of page 18, where the structures represented by graphic formulae XIV and XV are referred to as naphthols and thus were intended to include such hydrogen. The amendment to Reaction D was made to include a hydrogen atom that was inadvertently cutoff of graphic formula XV when the document was printed because the margins of the reaction scheme were incorrectly set.

Claims 1, 2 and 3 have been amended. The amendments to the claims do not constitute new matter but rather find basis in the specification. The amendments to claims 1, 2 and 3 were made for the purpose of correcting the inadvertent omission of side letters in the graphic formula, to include a proviso to exclude fluoren-9-ylidene as a substituent which conforms the claims to the specification, to provide antecedent basis for the terms "first R₃ and second R₃" ring and "R₃" ring, to correct a typographical error and to further clarify the location of the R₃ rings.

More specifically, claim 1 was amended to include the letters identifying the sides of the graphic formula in lines 5-14 as shown by the strikethrough of the original graphic formula and the underlining of the new graphic formula; to include the proviso that when R₁ and R₂ come together to form a spiro-carbocyclic ring that "said spiro-carbocyclic ring is not fluoren-9-ylidene"; and to include "first R₃ and second R₃" after the statement in (b) that "each pair of substituents independently forms a" and before the statement in (b) "substituted or unsubstituted fused carbocyclic or heterocyclic ring". Basis for the changes to the graphic formula are found on page 5 in graphic formula I; for the proviso to exclude fluoren-9-ylidene is on page 8, lines 5-13; and for the inclusion of "first R₃ and second R₃" is found in the paragraph bridging pages 10 and 11.

Claim 2 was amended by inserting "R₃" after "heterocyclic" and before "ring" in (b) and by replacing a semicolon with a period to end the claim. Basis for this amendment is found on page 11 lines 3-15.

Claim 3 was amended by inserting "R₃" prior to "ring" in (b) and to remove the "o" and "q" sides as potential sites for the R₃ ring by placing double brackets around the letters. Basis for this amendment is found on page 11 in lines 16-24.

Applicants acknowledge the allowance of claim 4 and respond to the rejection of the remaining claims in the following sections.

FIRST REJECTION - 35 USC §112

Claims 1-3 and 5-21 have been rejected under 35 USC §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicants respectfully request reconsideration and withdrawal of this rejection.

Claims 1 and 2 have been amended to correct the deficiencies pointed out by the Examiner by correcting various typographical and clerical errors, providing antecedent basis inadvertently omitted and conforming the claims to the specification.

Specifically, claim 1 was amended to include the letters identifying the sides of the graphic formula; to include the proviso that when R₁ and R₂ come together to form a spiro-carbocyclic ring that "said spiro-carbocyclic ring is not fluoren-9-ylidene"; and to include "first R₃ and second R₃" to provide antecedent basis for these terms which are later used in (b). Claim 2 was amended by including "R₃" in (b) to provide antecedent basis and by replacing a semicolon with a period to end the claim. Claim 3 was amended to identify the "p" side as the location for the R₃ ring as indicated in the specification. None of these amendments introduce new matter, rather all of the amendments find a basis in the specification. Reconsideration and withdrawal of this rejection is respectfully requested.

SECOND REJECTION - 35 USC §102(e)

Claims 1-3 and 5-15 have been rejected under revised 35 USC §102(e) as being anticipated by JP 2000-327675. Applicants respectfully request reconsideration and withdrawal of this rejection.

None of the provisions of either the old or revised 35 USC §102(e) apply to the Japanese publication JP 2000-327675. JP 2000-327675 was not filed in the United States prior to Applicants' present invention so it is not an application for patent published under 35 USC §122(b) and it is not an international application filed under the treaty as defined in 35 USC §351(a). JP 2000-327675 is a Japanese patent application filed in the Japanese Patent Office and published on November 28, 2000. It's effective date as a reference is the date of publication. Applicants respectfully submit that the rejection is not proper.

In light of the preceding statements, reconsideration and withdrawal of the rejection is respectfully requested.

THIRD REJECTION - 35 USC §103(a)

Claims 1, 3 and 16-20 have been rejected under 35 USC §103(a) as being unpatentable over JP 2000-327675 in view of Van Gemert (U.S. 5,645,767). Applicants respectfully request reconsideration and withdrawal of this rejection.

Applicants have concurrently filed a declaration under 37 CFR §1.131 to establish that Applicants were in possession of the completed invention of the rejected claims prior to the publication date of JP 2000-327675 which was November 28, 2000, i.e., the effective date of the reference.

The evidence submitted is a copy of notebook pages revealing that several claimed compounds of the present application were completed prior to the effective date of the reference. Applicants submit that the declaration is sufficient to establish possession of the completed invention, commensurate with the invention as claimed, prior to the effective date of the reference, even though, the declaration does not show the identical oxo-substituted compound disclosed in JP 2000-327675. See MPEP 715.02.

Even if Applicants' declaration were not considered fully commensurate with the scope of the rejected claims, Applicants submit that the rejection over the reference is still overcome. It would have been obvious to one skilled in the art to prepare the oxo-substituted compounds of the reference in view of the evidence in the declaration. See the following section of MPEP 715.02.

Even if applicant's 37 CFR 1.131 affidavit is not fully commensurate with the rejected claim, the applicant can still overcome the rejection by showing that the differences between the claimed invention and the showing under 37 CFR 1.131 would have been obvious to one of ordinary skill in the art, in view of applicant's 37 CFR 1.131 evidence, prior to the effective date of the reference(s) or the activity. Such evidence is sufficient because applicant's possession of what is shown carries with it possession of variations and adaptations which would have been obvious, at the same time, to one of ordinary skill in the art.

In view of the evidence submitted in the concurrently filed 37 CFR 1.131 declaration, JP 2000-327675 is not a proper basis for rejection and may not be combined with Van Gemert.

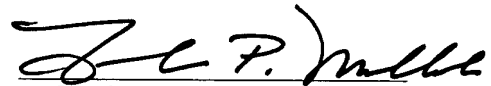
Van Gemert alone does not make obvious Applicants' invention. Although naphthopyran compounds of Van Gemert maybe considered isomers to corresponding compounds of Applicants' claimed invention, they demonstrate different properties and are made by different chemical reactions. Examples 1-9 of Van Gemert demonstrate an activated bluish color, are slow to fade having a reported bleach rate of from 119 to 401 seconds, a Sensitivity of from 0.57 to 1.20 and an ΔOD at Saturation of from 0.61 to 0.89. Examples 1-18 of Applicants' invention demonstrate an activated brownish color, are fast to fade having a bleach rate of from 24 to 153 seconds, a Sensitivity of from 0.09 to 0.19 and an ΔOD at Saturation of from 0.04 to 0.34. Reactions C, D and G used to produce the compounds of Applicants' invention are not disclosed in Van Gemert.

In light of the preceding remarks, Applicants respectfully request reconsideration and withdrawal of this rejection.

In the event that the Examiner finds that the foregoing amendments and remarks do not place this application in condition for immediate allowance, it is requested that the Examiner contact Applicants' Agent at the telephone number found below to arrange for an interview to discuss the claims of the present application before the Examiner issues another Communication.

Respectfully submitted,

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A handwritten signature in cursive script, appearing to read "F. P. Mallak".

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August 7, 2003